

**PATENT****REMARKS**

Claims 1, 4-7, 11-15 and 20 remain pending in this application. Claims 1, 3, 8-10 and 16-19 were withdrawn from consideration.

In the Office Action, Claims 1, 5, 7, 11, 12 and 13 were rejected under 35 USC 102(b) as allegedly being anticipated by U.S. Patent 5,068,783 to Tanagawa et al. Claims 4, 6, 14, 15 and 20 were rejected under 35 USC 103 (a) as allegedly being unpatentable over Tanagawa et al. Claims 6, 13 and 15 were rejected under 35 USC 112, second paragraph as being indefinite. Claims 4 and 6 were further objected to as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 2, 6 and 15 have been amended in this application. These amendments are being made for clarification and are not narrowing amendments made for reasons of patentability. All claims are allowable for the reasons set forth below.

**Rejections Under 35 USC 102(b)**

Claims 1, 5, 7, 11, 12 and 13 were rejected under 35 USC 102(b) as allegedly being anticipated by U.S. Patent 5,068,783 to Tanagawa et al. Assignee respectfully submits that the present claims are novel in view of Tanagawa for several reasons.

First, Tanagawa does not disclose system code as set forth in the present claims. This system code is executed during system level testing of the subject electronic device, and system level testing may be performed during the manufacturing process. The system code provides advantages in that it may be used to minimize the programming and set-up burden on the consumer. For example, consumer-specific preference information may be uploaded to the electronic device during the manufacturing process. These advantages were disclosed in the application as filed at page 7, lines 8-15 as follows:

"In one embodiment, the second input device 28 uploads to the memory location 14 preference information 32 unique to the consumer 30 purchasing the electronic device 12. Where the electronic device 12 is a cellular phone, this information may include identifying information such as the phone number, speed dial numbers, ring volume, and phone system features. This allows a consumer 30 to

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operate a new cellular phone without having to perform any significant programming. Default parameters can also be uploaded where the consumer 30 does not have preference information 32 concerning a feature."

In support of its assertion that Tanagawa provides system code, the office action directs Assignee's attention to the portion of Tanagawa wherein it is disclosed that programs stored in mask ROM may include an ordinary application program of the type provided for the microcomputer. The cited portions of the disclosure also provide that the program may be for VTR control or for additional functions associated with VTR control. Tanagawa does not disclose special programming that would provide for consumer-specific preference information to be pre-programmed into the consumer's electronic device during the manufacturing process.

Moreover, the present disclosure provides for partial system code to be uploaded, while other code may be uploaded at a later time. Uploading the system code in two portions provides several advantages, including the reduction of upload process time and the ability to accommodate smaller memory devices, e.g., those used in portable electronic devices.

In this connection, Assignee respectfully directs the Examiner's attention to FIG. 1 and page 8, line 27 through page 9, line 7 of the application as filed. Particularly, by already uploading some of the system code, the upload process time is reduced. The amount of system code uploaded may depend on the size of the memory location since a larger size would be required to accommodate the entire system code as well as the test code simultaneously. Another factor will be the amount of system code already installed in the memory location, as discussed above. Furthermore, the selection of memory device will also impact the amount of system code that is initially loaded. To minimize the size of the memory location, the portion of system code loaded may overwrite the test code already stored in the memory location. This system code may consist of unique code for the electronic device in contrast with the common code previously uploaded.

Therefore, in addition to other elements not disclosed by Tanagawa, such as system code and the use of partial system code, Tanagawa makes no reference to portable electronic devices.

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**Rejections Under 35 USC 103(a)**

Claims 4, 6, 14, 15 and 20 were rejected under 35 USC 103(a) as allegedly being unpatentable over Tanagawa et al. Assignee submits that a *prima facie* case of obviousness has not been made. A *prima facie* case of obviousness requires that the references teach or suggest all claim limitations. As set forth above, Tanagawa does not teach, among other things, system code. Therefore, a *prima facie* case of obviousness has not been established since the prior art does not teach or suggest all claim limitations.

For a *prima facie* case of obviousness, there must also be a suggestion or motivation to modify or combine the references. Assignee respectfully submits that the claims herein are not obvious in view of Tanagawa. The invention described in the pertinent claims would not have been obvious since, to customize each product for each user, fabrication time would be increased and the cost would eventually be passed on to the consumer. The present disclosure provides customized programming without increasing the size of the memory allocated for such programming, or reducing portability in the electronic device.

More particularly, in accordance with the present disclosure, at least a portion of the system code may be uploaded in parallel with test code. Accordingly, upload process time is reduced. The present disclosure also provides for user-customization through the use of memory such as EPROM, EEPROM, and flash-ROM. These types of memory can be used in the portable electronic device with the benefit of minimizing the size of the memory location pertaining to system code for user-customization, since manufacturing and operational software can reside in series in the memory location for the electronic device. Tanagawa does not teach or suggest user-customization and addressing memory or processing time associated therewith.

Accordingly, Assignee respectfully submits that this rejection has been overcome.

**Rejections Under 35 USC 112, Second Paragraph**

Claims 6, 13 and 15 were rejected under 35 USC 112, second paragraph as being indefinite. Claims 6 and 15 were rejected as allegedly indefinite based on the term "U/I". Claims 6 and 15 have been amended to further clarify the present invention. Particularly, these claims were amended to replace the term "U/I" with --user interface--. The term user interface is

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well known in the art, and a person of ordinary skill in the art would be able to determine the meaning of this term through a review of the present disclosure. No new matter has been added.

Claim 13 was rejected as allegedly being "confusing" since because it claims the first and second input device as being the same, while the parent Claim 12 indicates they are separate. Assignee respectfully submits that a single input device could be used that includes the limitations of the first and second input devices. Claim 13 further limits Claim 12 by requiring that the first and second input devices are the same.

Assignee respectfully requests that this rejection be withdrawn.

**Objections Under 37 CFR 1.75(c)**

Claims 4 and 6 were further objected to as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Assignee respectfully disagrees with these objections as Claims 4 and 6 clearly further limit the subject matter of Claim 1.

Claim 4 depends from Claim 1, which recites "[a] method of parallel programming an electronic device's memory with test code and system code prior to board level testing during manufacturing..." The body of the claim includes limitations for an electronic device. The electronic device inherently includes memory. Claim 4 further limits Claim 1 in that it requires the memory location to be flash memory. Please also note that the device is programmed with instructions and the instructions are executed.

Claim 6 depends from Claim 1, which requires "programming said electronic device with third instructions, wherein said third instructions include system code to complement said second instructions and executing said second instructions and said third instructions during system level testing of said electronic device." Therefore, the third instructions are manipulated by execution during system level testing of the device.

Claim 6 depends from Claim 1 and includes the further limitation that the third instructions are user interface codes.

Assignee respectfully requests that this objection be withdrawn.

**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is now in condition for allowance, and accordingly, reconsideration and

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allowance are respectfully requested. Should any issues remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone Assignee's undersigned attorney.

If there are any fees due in connection with the filing of this response, please charge such fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for, such an extension is requested and the fee should also be charged to our Deposit Account. A duplicate copy of this page is enclosed.

Respectfully submitted,

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